



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/400,769	09/22/99	HELMERHORST	E 28594/35007A

HM12/1214  
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EXAMINER	
ROBINSON, H	
ART UNIT	PAPER NUMBER

1653

DATE MAILED:

12/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/400,769

Applicant(s)

Helmerhorst et al.

Examiner

Hope Robinson

Group Art Unit

1653

☒ Responsive to communication(s) filed on Jun 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-19 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Election/Restriction***

1. Applicant's election with traverse of Group II (Claims 5-19) in Paper No. 8 filed October 2, 2000 is acknowledged.

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2. The previous Restriction Requirement mailed on June 28, 2000 has been withdrawn and a new Restriction Requirement is set forth as follows:

3. Restriction to one of the following inventions is required under  
10 35 U.S.C. 121:

I. Claims 1-4 are drawn to a method of treating a patient suffering from one or more insulin related ailments, classified in class 514, subclass 3.

15 Claims 1-4 encompasses several different amino acid residues. If the invention of Group I is elected, Claims 1-4 will be examined only in-so-far as it pertains to the selection of one of the amino acid residues.

II. Claims 5-19 are drawn to a method of treating a patient via a non-peptidyl compound, classified in class 514, subclass 23.

20 Claims 5-19 encompasses different amino acid residues; different designations for V, W, R and Y; and several different compounds. Specifically claim 5 has amino acid residues (i) to (xxxii); claims 5-9 and 11-14 have different designations for V, W, R and Y; Claim 10 has compounds (i) to (xiv) and claim 15 has compounds (xv) to (xxviii). Therefore, if the invention of Group II is  
25 elected, Claims 5-16 will be examined only in-so-far as it pertains to the selection of one of the amino acid residues listed in (i) to (xxxii); one designation for V, W, R and Y; and one compound from the listing (i) to (xiv)

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of claim 10 and; (xv) to (xxviii) of claim 15.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I-II are separate and distinct because the method of Invention II has non-peptidyl components. Therefore, the methods have different steps and different products with differing functions, thus are patentably distinct.

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Because these inventions are distinct for the reasons given above and have acquired as separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 8:30 A.M. to 6:00 P.M. (EST).

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2923.

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
Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile

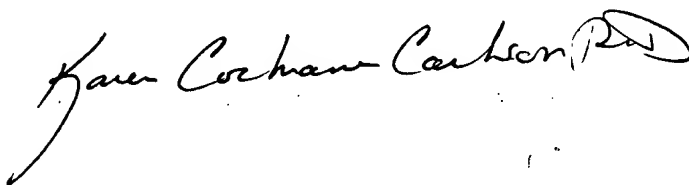
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transmission. The official fax phone number for Technology Center 1600 is  
(703) 308-4242. Please affix the Examiner's name on a cover sheet attached to  
your communication should you choose to fax your response. The faxing of such  
papers must conform with the notice published in the Official Gazette, 1096 OG  
5 (November 15, 1989).

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Hope A. Robinson, MS 

Patent Examiner



KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER